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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,420	01/04/2002	Alan R. Loudermilk	DBT-005	8866
7590	09/29/2005		EXAMINER	
Loudermilk & Associates PO Box 3607 Los Altos, CA 94024-0607			CHAN, WING F	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,420	Applicant(s) LOUDERMILK ET AL.	
	Examiner Wing F. Chan	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2643

1. This office action is in response to applicant's response filed 9/16/05.
2. The abstract of the disclosure is objected to because it is not directed to the claimed invention. Correction is required. See MPEP § 608.01(b).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1 starting from line 9 onward "the one or more users" (all occurrences) lacks clear antecedent basis since only "a plurality of users" was previously recited in line 7; in line 20 "a particular user" lacks clear antecedent basis and fails to provide any relationship to the plurality of users; in lines 23, 24, 26, 27 "the particular user" also lack clear antecedent basis; in line 23 "the user" lacks clear antecedent basis. These antecedent basis problems render the claim confusing and indefinite.

As to claim 11 in line 20 "a particular user" lacks clear antecedent basis and fails to provide any relationship to the plurality of users; in lines 23, 24, 27 "the particular user" (all occurrences) also lack clear antecedent basis; in line 23 "the user" lacks clear

Art Unit: 2643

antecedent basis. These antecedent basis problems render the claim confusing and indefinite.

Claim 29 is indefinite in that is the caller the same as the user or is there a separate user controlling the music generation.

Dependent claims 2-10, 12-28, 30 are also rejected for the same reason since they are dependent on a rejected base claim and contain the same problem(s).

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 9, 19, 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for new claims 29-30 as is now claimed. The specification on page 79 line 5 to page 81 line 21 discloses a PBX telephone system having music generation engines for providing the on-hold music function, and there is no detailed description as to the on-hold music function being generated by a telephony device as is now claimed in new claims 29-30. Therefore, the specification is inadequately written to provide support for new claims 29-30.

Art Unit: 2643

The specification also fails to provide written support for the limitation "volume, beat and filtering parameters" as is now claimed in claims 9 and 19.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

8. Claims 1-30 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. US PAT. NOS. 6,815,600 6,897,368, 6916978 to patentee Georges of France contains the same identical specification as the present application, and the patents to patentee Georges also claims foreign priority to a earlier foreign priority document 02368003.6 from the EPO. Further, as set forth in the front page of the Georges patents, the applicant of the present application Mr. Loudermilk is the attorney for patentee Georges but Mr. Loudermilk is not named as being a co-inventor in the Georges patent. Therefore, a question is raised as to who is the actual inventor of the claimed subject matter in the present application and a rejection under 35 U.S.C. 102(f) is therefore warranted.

9. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Levy et al (US PAT. NO. 4,577,067 hereinafter Levy).

Levy discloses a method and system for providing on-hold music in a telephony environment (device) such as a PBX (e.g. col. 4 lines 18-21) comprising the steps of; providing at least one music generation engine (e.g. program sources 44, 48, 52, 56, see col. 4 line 58 to col. 5 line 8) in the telephone device, wherein the at least one music generation engine generates music of one of a plurality of styles of music (e.g. col. 5 lines 5-8); receiving a telephone call from a caller; wherein, when the caller is placed on-hold, controlling the at least one music generation engine to automatically compose on-hold music that is audibly provided to the caller; wherein, in response to one or more first commands entered by a user, on-hold music of a particular style is selected by the user (e.g. see abstract) and the music generation engine is controlled so that the at least one music generation engine generates via autocomposition on-hold music of the particular style selected by the user. Note col. 2 line 17 to col. 3 line 31, col. 3 line 62 to col. 13 line 65 for example.

10. The following would apply only if applicant is able to overcome the 35 U.S.C. 102(f) rejection.

11. Claims 1-28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.


12. Applicant is advised that should claims 1-10 be found allowable in a reply to this Office action, claims 11-20 will be objected to under 37 CFR 1.75 as being a substantial

duplicate thereof and vice versa. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 571-272-7493. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Wing F. Chan
Primary Examiner
Art Unit 2643

9/27/05